

REMARKS

In response to the Office Action dated October 31, 2008, Applicants respectfully request reconsideration of the rejections of the claims. However, the Examiner is thanked for the detailed Office Action.

The foregoing amendments include only two minor changes which do not affect the scope of the claims. Accordingly, the Examiner is respectfully requested to enter the amendments after final rejection.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, and 16 - 26 are rejected under 35 U.S.C. § 103, on the basis of the *Farrell* and *Trovinger* (US 6,873,426 and US 6,708,967, respectively). Claims 3, 6, 9, 12 and 15 were rejected on the basis of *Farrell* and *Trovinger*, in view of *Jeyachandran* (US 6,567,176). For the reasons presented in Applicants' previous responses, and further discussed hereinafter, it is respectfully submitted that these reference do not suggest the claimed subject matter to a person of ordinary skill in the art, whether considered individually or in combination.

The claimed subject matter has been summarized in several previous responses, and it is assumed that the Examiner is familiar with the summaries and arguments made in the previous responses.

Claim 1 recites, among other elements, a printing system having an on-line client, a print server and printer, and an off-line finishing device. The claim recites that the print server includes a first memory for storing specifications of the on-line printer **and of the off-line finishing device**, as well as information regarding options installed thereon. Claim 1 further recites that the printing system includes a sorter for separating finishing specifics included in a job ticket into those to be performed by

the on-line printer and those to be performed by the off-line finishing device, "based on the information regarding the specifications and installed options that is stored in the first memory". As a result of the information that is stored in the memory, the print server is able to create a finishing device job ticket that includes those functions that can be performed by the off-line finishing device. ***This feature avoids the creation of a ticket having functions that cannot be performed by the off-line finishing device.***

In rejecting Claim 1, the Office Action acknowledges that the *Farrell* patent "does not expressly disclose a printing system further comprising an off-line finishing device." Office Action at page 12. To this end, the Office Action notes that the *Trovinger* patent discloses an off-line finishing device, which receives papers and a job ticket from another device. The Office Action concludes that it would be obvious to modify the system of the *Farrell* patent, to include an off-line finishing device in view of the *Trovinger* patent.

In the prior response, it was argued that the *Farrell* patent does not disclose a printing system that stores information about an on-line printer and a distinct, i.e., off-line, finishing device, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus, the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9-22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent

suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

In paragraph 2, on page 6, of the last Office Action, the Examiner attempts to support his position by stating that "*Farrell* does suggest that the printing system has knowledge of any of the particulars of an off-line finisher...", citing column 3, lines 16 - 17. However, that citation relates to easing the transition from on-line to off-line finishing. As is explained later in the reference, such action merely includes generating a marker indicative of the desired finishing to be later applied. See column 5, lines 23 - 26. ***There is no teaching or suggestion in Farrell that the printer has any knowledge of the capabilities of the off-line system when generating the marker.***

The Examiner relies solely upon one statement in *Farrell*: "Yet another advantage of the present invention resides in the easy transition from on-line to off-line finishing.", found at column 3, lines 16 - 17. Applicants submit that this statement, and the reference as a whole, is insufficient to establish that the printer disclosed in *Farrell* has any information concerning the capabilities of an off-line finisher. Accordingly, the Examiner's conclusion in paragraph 2 is completely without foundation.

The Examiner further states in paragraph 3, on page 6, of the Office Action that "*Farrell* does disclose that these indicators are generated with knowledge of the specifications of a particular off-site finisher...", citing again column 3, lines 16 - 17. However, the supplying of desired finishing instructions, as taught by *Farrell*, ***is done without any knowledge of the capabilities of the off-line system.*** And, the Examiner has never cited any language in either reference to the contrary.

The Examiner again relies solely upon the same one statement in *Farrell*. Applicants submit that this statement, and the reference as a whole, is insufficient to establish that the printer disclosed in *Farrell* has any information concerning the capabilities of an off-line finisher. Accordingly, the Examiner's conclusion in paragraph 3 is also completely without foundation.

If the Examiner persists with the position that *Farrell* has knowledge of the capabilities of an off-line finisher, the Examiner is respectfully requested to cite some specific evidence of this position. Otherwise, the Examiner is respectfully requested to reconsider and withdraw the rejection.

In view of the foregoing, it is respectfully submitted that the *Farrell* patent does not disclose the subject matter for which it is being relied upon in the rejection of the claim, namely a printing system that stores information about both an on-line printer and an off-line finishing device, and which assigns finishing specifics to these respective devices based upon such stored information. While the *Trovinger* patent discloses an off-line finishing device, there is no showing in the Office Action that it discloses the subject matter that is missing from the *Farrell* patent. Consequently, any logical combination of the teachings of the *Farrell* and *Trovinger* patents, to provide a printing system having both an on-line printer with a finishing element, and an off-line finishing device, would not result in the subject matter of claim 1. Reconsideration and withdrawal of the rejection of Claim 1 is therefore respectfully requested.

It is respectfully submitted that pending independent claims 4, 7, 10 and 13 also recite this distinguishing subject matter. For the same reasons, therefore, the *Farrell* and *Trovinger* patents do not suggest the subject matter of any of these

claims to a person of ordinary skill in the art, even when they are considered in combination. Nor does the Jeyachandran patent overcome this difference.

Claim 16 recites a print server to be used in a printing system that includes a client, the print server, a printer on which at least one finishing option is installed, and a finishing device that is separately provided from the printer. The print server includes a first memory section that stores information on the specifications of the printer, the finisher, and the at least one finishing option installed on the printer. The print server also includes a control section that separates the finishing specifics included in a job ticket into a first group of finishing specifics to be performed by the finishing option installed on the printer and a second group of finishing specifics to be performed by the finishing device, based on the stored information about the specifications of the printer, the finishing device, and the finishing option installed on the printer.

Claim 24 recites a print server that includes, among other elements, a memory for storing specifications of an on-line printer and of a finishing device and information on respective finishing features of each, and a sorter for separating the finishing specifics included in a job ticket into those to be performed by the on-line printer and those to be performed by the finishing device, based on the information regarding the specifications and installed options that is stored in the memory. Claim 22 recites a printing system that includes such a server.

Claim 26 recites a printing system having a server that includes, among other elements, a sorter for separating the finishing specifics included in a job ticket into those to be performed by an on-line printer and those to be performed by a finishing device, based on information regarding first and second finishing features of the on-

line printer and the finishing device, respectively. Claim 25 recites a computer-readable medium containing a computer program that performs the corresponding separating operation, based upon such information.

For reasons similar to those presented previously, it is respectfully submitted that each of these claims is patentably distinct from the teachings of the *Farrell* and *Trovinger* patents, whether considered individually or in combination. Each claim recites that the separation of finishing specifics between those to be performed by the printer and those to be performed by the finishing device is based upon information pertaining to both a finishing option (or feature) available on the printer and the specifications (or finishing feature) of the finishing device. As noted above, the *Farrell* patent only discloses that information pertaining to the available finishing options on the printer is stored, and used to determine how the print job is to be finished. There is no storage of information pertaining to the features of a finishing device that is distinct from the printer, let alone use of such information to determine which finishing operations are to be performed by the printer and which are to be performed by a distinct finishing device.

Other distinguishing features of the invention are set forth in the dependent claims. In view of the fundamental difference identified above, a further discussion of these additional distinctions is believed to be unnecessary at this time.

For the foregoing reasons, it is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Applicants respectfully request reconsideration and withdrawal of the rejections, and allowance of all pending claims.

Respectfully submitted,

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Date: March 2, 2009

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